



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

William B. Ardern II

Attorney Docket No. ARD-101US

Serial No. 10/664,634

Group Art Unit: 3611

Filed: September 19, 2003

Examiner: Gary Chapman Hoge

Title: BINDER CLIP SLEEVE

* * * * *

DECLARATION OF WILLIAM B. ARDERN II
UNDER 37 C.F.R. § 1.131

I hereby declare as follows:

1. I am the inventor of the subject matter claimed in U.S. Patent Application Serial No. 10/664,634 ("my application") directed to a Binder Clip Sleeve. In the improvement of this invention, I claim a tri-panel binder clip sleeve in combination with a binder clip and a method of affixing indicia to a binder clip. My application was filed on September 19, 2003.

2. I am informed that an office action was mailed February 21, 2006 in connection with my application. I am further informed that claims 1 and 3-5 of my application have been rejected under 35 U.S.C § 102(e) based on U.S. Patent No. D479,146 (Manley) (the "'146 patent") and that claims 2, 6-15, 17-25 and 27-33 have been rejected under 35 U.S.C § 103(a) based on the '146 patent alone or in combination with other references. I am informed that the '146 patent issued September 2, 2003 on an application filed January 17, 2003. I have been informed that the effective date for the '146 patent as a reference under 35 U.S.C. §§102(e)/103(a) is the date that it was filed, i.e., January 17, 2003.

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3. The specific facts, exhibits and information set forth in this declaration demonstrate that I had conceived and reduced to practice the subject matter claimed in my application prior to January 17, 2003.

4. Conception and reduction to practice of my invention is supported by attached Exhibit A. Exhibit A is a true and correct copy of a receipt from an OfficeMax office supply store confirming my purchase of supplies which I then used to make binder clip sleeve embodiments according to my invention. Exhibit A has a redacted date prior to January 17, 2003. Exhibit A includes highlighting and my handwritten notations appear next to the receipt.

5. As shown on Exhibit A, I purchased a three pack of binder clips and two different types of thin plastic sheet material for use in making binder clip sleeves to be affixed to the binder clips. The plastic sheet material was of a type used to laminate a document and was in the form of clear thin plastic sheets with approximate dimensions of about 8.5" x 14" x 3 mils (the "Legal Size Lami.") and about 8.5" x 11" x 3 mils (the "Menu Size Lam"). The plastic sheet material included adhesive on one side. The binder clips that I purchased were conventional binder clips which looked like the binder clip shown in Figures 1, 2, 3, and 5 of my application.

6. I used these materials to make working embodiments of my binder clip sleeve invention before January 17, 2003. For example, I made laminated binder clip sleeves using the abovementioned plastic sheet material. More specifically, I printed indicia in the form of text and graphic information on a paper substrate by hand or by using my ink jet printer. I sized and arranged the indicia so that it would fit on a binder clip with information on one or more of the panels of the binder clip body. I laminated a piece of the abovementioned plastic sheet material

over the paper substrate. I then cut the paper and plastic sheet laminate to the appropriate size so that it would fit around the three panels of the binder clip with the information showing on at least one of the three panels of the binder clip sleeve. I held the binder clip sleeve in place on the binder clip by using double sided tape and, in other embodiments, using adhesive applied directly to the paper substrate.

7. I am informed that a binder clip sleeve embodiment, such as described in paragraphs 4-6, would be covered by at least independent claims 1, 15, 23 and 27 of my application.

8. Conception and reduction to practice of my invention is further supported by attached Exhibit B which is a true and correct copy of a drawing I created showing three alternative binder clip sleeve embodiments. I am the author of Exhibit B; the exhibit is in my handwriting. Exhibit B has a redacted date prior to January 17, 2003. Exhibit B shows three different embodiments of my binder clip sleeve invention including (clockwise from upper left): (a) an end view of a tri-panel binder clip sleeve fitted over the spring body of a binder clip, (b) an end view of a tri-panel binder clip sleeve fitted tightly over the spring body of a binder clip and (c) an end view of a tri-panel binder clip sleeve fitted in frictional engagement over the spring body of a binder clip.

9. Exhibit B further includes a list of possible materials for use in making binder clip sleeves and further identifies methods by which the binder clip sleeves may be secured with respect to the binder clip. Exhibit B shows a view of the panels of a sleeve.

10. I made working embodiments of binder clip sleeves referenced in Exhibit B and paragraphs 8-9 above prior to January 17, 2003.

11. Conception and reduction to practice of my invention is further supported by attached Exhibit C which is a true and correct copy of an entry in my personal calender. I am the author of the entry; the entry is in my handwriting. Exhibit C has a redacted date prior to January 17, 2003. (Other dates are redacted as well.)

12. Exhibit C shows that I obtained plastic sheet material for use in making an embodiment of my binder clip sleeve invention. Exhibit C states, "Stop at plastics company for samples for binder clip covers in Menomonee Falls." I did, in fact, obtain the plastic sheet material on or about the day shown in my calender. The plastic material was clear LEXAN brand sheet material. The LEXAN was rigid and was relatively thick.

13. I made working embodiments of my binder clip sleeve invention using the LEXAN material referenced in Exhibit C prior to January 17, 2003. I cut the LEXAN into a strip approximating the size of the binder clip metal spring body. I then placed the LEXAN in a vice and bent it to correspond to the shape of the three panels of the binder clip so that the LEXAN strip would overlie the binder clip spring body and be held in place by friction. I then placed a binder clip sleeve with indicia between the LEXAN sleeve and the binder clip body so that the indicia could be seen through the LEXAN. Exhibit D shows two working embodiments of my binder clip sleeve that I made before January 17, 2003 using the abovementioned LEXAN material.

14. I am informed that binder clip sleeve embodiments such as described in paragraphs 11-13 would be covered by at least independent claims 1, 15, 23 and 27 of my application.

15. I made binder clip sleeve embodiments, other than those described above, before January 13, 2003 and can elaborate on them if that would be deemed useful.

16. After I conceived and reduced to practice my invention, I set about locating a patent attorney to assist me in obtaining patent protection for my invention. (I wish to reserve my attorney-client privilege. The following information is not intended to be a waiver of or estoppel to assertion of such privilege.)

17. On February 13, 2003 I sent an e-mail to the law firm of patent attorney John E. Munger. A true and correct copy of my e-mail is attached as Exhibit E. I am the author of this e-mail. I am advised that the e-mail is in the printed form as received by Mr. Munger's office. I am not the author of the hand written notations in the lower right portion of Exhibit E.

18. In my e-mail, I state that I had made a prototype of my invention. This is a true and correct statement.

19. On February 19, 2003 I met with Mr. Munger at his law office. Attached Exhibit F comprises true and correct copies of a three page document titled "Invention Idea Described." I gave Exhibit F to Mr. Munger at the February 19 meeting. I am the author of the documents comprising Exhibit F although I did not write the February 19, 2003 date on the documents.

20. Also on February 19, 2003, I showed Mr. Munger working embodiments of my binder clip sleeve invention. Exhibit G is a photograph which shows three binder clip sleeves provided to Mr. Munger and discussed at the February 19, 2003 meeting. I am informed that the picture comprising Exhibit G was taken on February 20, 2003.

21. The fact that I was seeking the assistance of a patent attorney, was meeting with a patent attorney and was showing the attorney my invention all on dates in very close proximity to the January 17, 2003 filing date of the application resulting in the '146 patent is supportive of my having completed my invention before such application was filed.

22. I have submitted a declaration including the same facts set forth in this declaration on the issue of proof of invention in connection with each of my co-pending U.S. design patent applications identified by Serial Nos. 29/190,249 and 29/190,250. I am informed that the declarations were accepted by the Examiner in these applications and that the '146 patent was withdrawn as a reference in these applications.

23. I hereby declare that all statements made herein of my own knowledge are true. I further declare that these statements are made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both under 18 U.S.C. §1001 and that such willful false statements may jeopardize the validity of my application or any patent issuing thereon.

By: William B. Ardern II
William B. Ardern II

Dated: March 16, 2006
March 16, 2006

OFFICEMAX #17
9088 North Green Bay Road
MILWAUKEE, WI 53209 (414)362-8000

0017 00001 79192 5

SALE 524047 06:23 PM

Binder clips →
Plastic laminates →
purchased for
prototypes

070530671827	Uniball Vision	8.29
072512095300	Icy Pencil .5mm	3.19
027755200073	Binder Clip 3Pk	4.99
027755300230	2 Large Binder	2.99
045888711112	Zazzle Brights	9.99
013465502934	Legal Size Lami	12.49
013465502231	Menu Size Lam.	14.49

7	ITEMS	SUBTOTAL	56.43
56.43	WI	TAX 5.600%	3.17
		TOTAL	\$59.60

XXXXXXXXXXXX5339 MSTRCD 59.60
CARDHOLDER: WILLIAM B ARDERN II

96447556

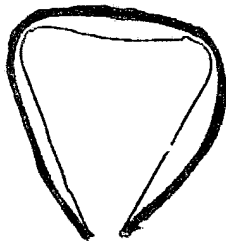
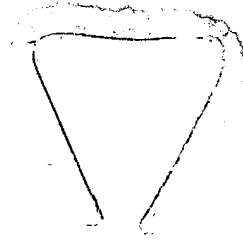
I AGREE TO PAY ABOVE TOTAL AMOUNT
ACCORDING TO CARD ISSUER AGREEMENT.

William B Arder II

EXHIBIT

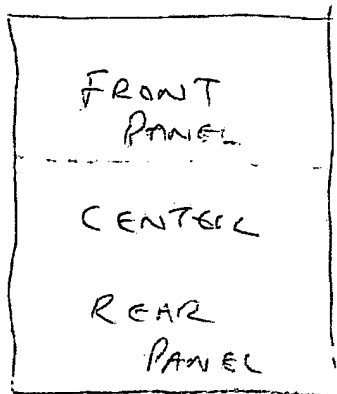
A

Binder Clip Covers



POSSIBLE WRAP MATERIALS

- ✓ Plastic
- ✓ Metal
- ✓ Cardboard
- ✓ Heavy Paper.



Methods of Attachment

- Friction
- Glue

16 MONDAY

8 Call Rogers 414-274-1620 1 Stop at photo company

9 2 for people's for

10 3 Linda's shop across

11 4 in Penn. Hall

12 Evening

17 TUESDAY

8 1

9 2

10 3

11 4

12 5

Evening

18 WEDNESDAY

8 1 Col's field trip

9 2 To Huber's land

3 3 13000 Silver St

4 4 414-247-5457

5 5 No. Kansas

6 6

7 7

8 8

9 9

10 10

11 11

12 12

Evening

THURSDAY 19

8 1 Col's field trip

9 2

10 3

11 4

12 5

Evening

FRIDAY 20

8 1

9 2

10 3

11 4

12 5

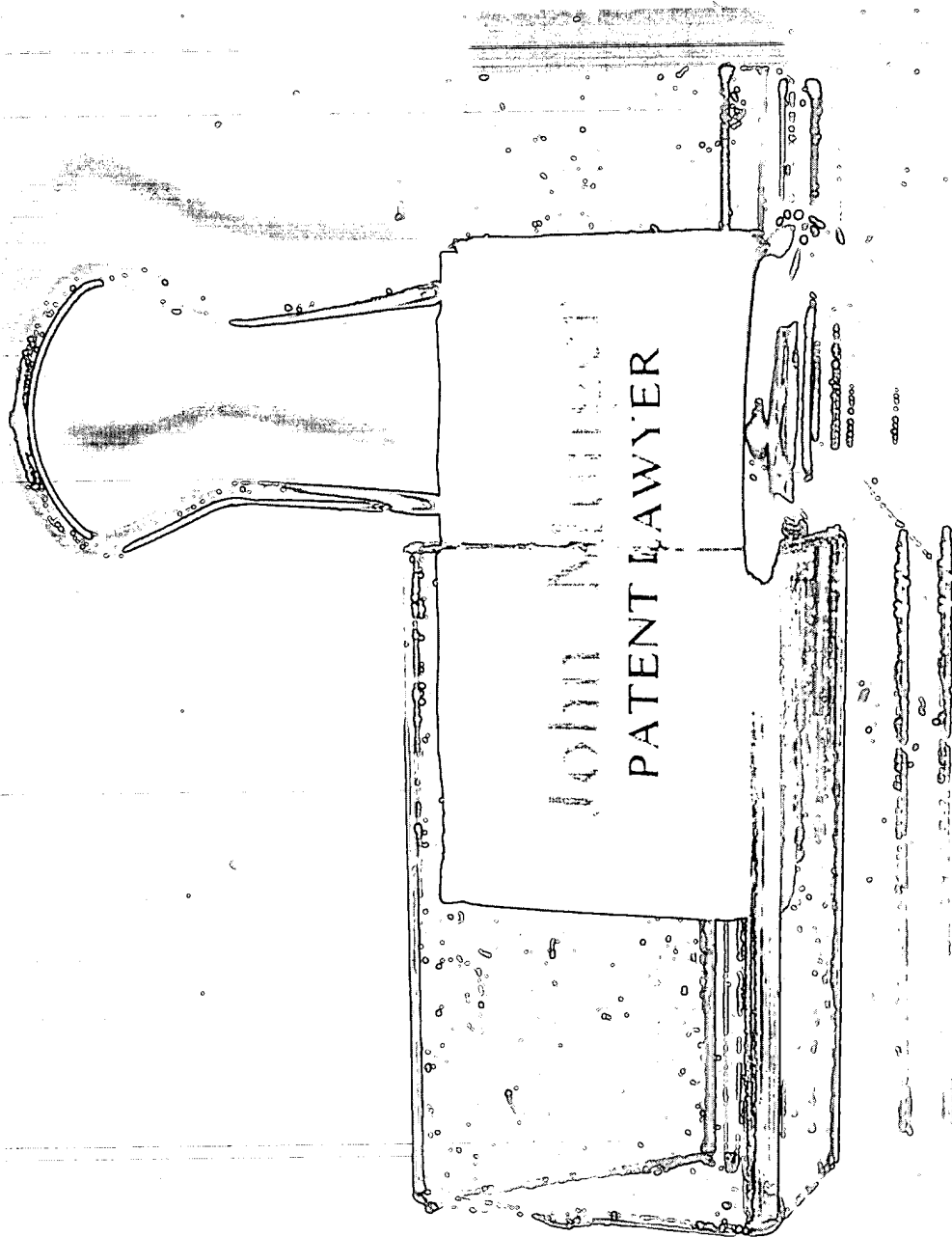
Evening

21 SATURDAY

SUNDAY 22

EXHIBIT

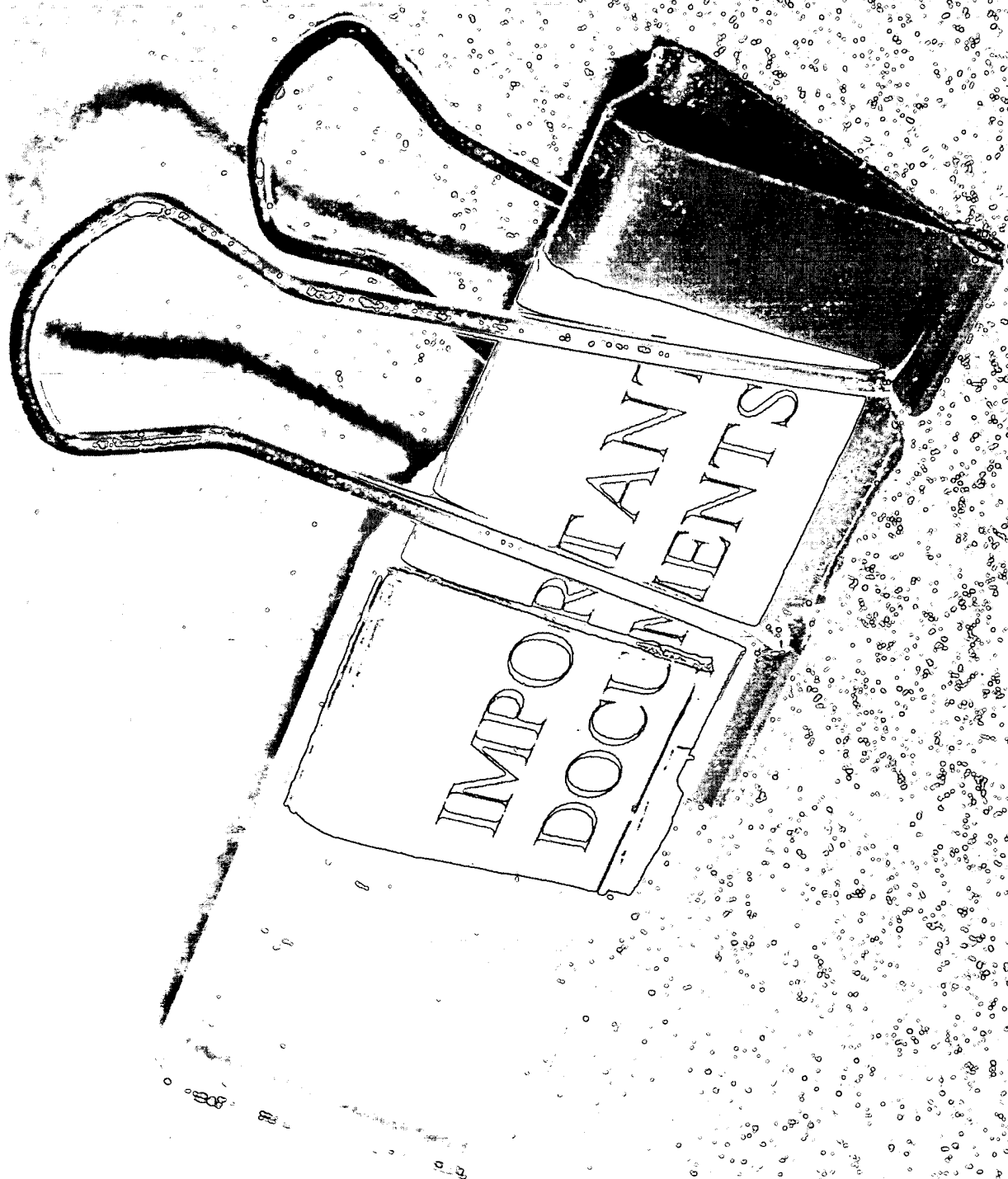
C



EXHIBIT

D








Inbox (334/79)



From: William Ardern <wis-analysts@execpc.com> 

To: janlaw@janlaw.com

Date: 02/13/03 20:51:01

Subject: Inquiry About The Estimated Cost To Evaluate A Product Idea For A Design Patent

I am located in Milwaukee and would like to know the estimated cost to evaluate an invention idea with with respect to its patentability. It is a relatively simple idea and I have made a prototype of it. The evaluation would be to provide me with a professional opinion whether a design patent could be obtained for the invention idea.

Assuming it would be feasible to obtain a design patent, would would you estimate the cost to obtain a design patent ?

Ultimately I do not believe I am interested in manufacturing the item. Has your firm had experience working with patent brokers ?

Sincerely,

Bill Ardern
262-241-1500



Inbox (334/79)



*Patent design
950 + 165
(5 mail)
smith
+ drawing
24/2/03*



February 19, 2003

Invention Idea Described

"Message Clips"

The idea is an add-on attachment to existing binder clips that are marketed for holding groups of paper together.

It is unique in that it transforms the binder clip into a mini desktop billboard. A simple metal binder clip is converted into a product that has use as a promotional item, as well as a hybrid form of business button.

The invention idea is to use colored plastic molding to wrap around existing binder clips. The plastic molding can be in different colors and/or textures, and be designed to be printed or embossed onto. In addition to plastic, it can be made of metal, wood, and cardboard.

Since the binder clips have three sides or faces, messages can be printed or embossed on all three sides. The binder clips are manufactured and marketed in numerous sizes from very small (3/8") to over 2". The message clip concept would primarily be for the binder clips 1/2" and larger to permit readability, but they could be made for all sizes of binder clips.

Functionality

- Fosters Good Organization
- Different Sizes Encourage Many Uses
- Flexible Way To Keep Documents Together
- Practical Uses in Business & Home
- Most Effective Non-Permanent Paper Fastener

Advantages of This Advertising

- Great Exposure.....All Businesses Can & Do Use Them
- Unique Desktop Advertising.....Mini Billboards
- Staying Power.....People Keep Them Forever
- Unique Format.....Three Sides For Advertising Copy

Market Potential

Holiday Message Clips

The message clips can be marketed and sold for all major holidays. Various designs oriented to each holiday can make binder clips a practical, low cost, decorative item for a broad market of both business and non-business uses.

- | | | |
|----------------|------------------|---------------------|
| ❖ Birthdays | ❖ Fourth of July | ❖ New Year's |
| ❖ Christmas | ❖ Halloween | ❖ St. Patrick's Day |
| ❖ Easter | ❖ Hanukkah | ❖ Thanksgiving |
| ❖ Father's Day | ❖ Mother's Day | ❖ Valentine's Day |

EXHIBIT

F

Message Clips for Business Use

The message clip transforms a nondescript, plain binder clip into a communication tool. Standard business messages can be printed or embossed onto the plastic or other material. The background color, as well as letters or designs, can range from standard to custom.

Examples of some of the basic messages that can be manufactured and sold in all major office supply stores and over the Internet are as follows:

- | | |
|----------------|------------|
| •IMPORTANT | •January |
| •URGENT | •February |
| •RUSH | •March |
| •HIGH PRIORITY | •April |
| •A S A P | •May |
| •CONFIDENTIAL | •June |
| •TAKE ACTION | •July |
| •THANK YOU | •August |
| •PHOTOCOPY | •September |
| •Monday | •October |
| •Tuesday | •November |
| •Wednesday | •December |
| •Thursday | |
| •Friday | |

Promotional marketing businesses can have message clips customized to suit their needs. Examples of how message clips can be utilized by all types and sizes of businesses are as follows:

- Company Name
- Company Name & Telephone
- Company Name, Address, Telephone
- Company Name, Slogan, Telephone
- Company Name & Logo
- Company Name & Website Address

Other Markets

Similar to buttons, pins, and even bumper stickers, the text and images that can be placed on the three sides of a message clip are endless. Any saying, image, or message that has appeared on a button, lapel pin, bumper sticker, or other promotional item could appear on a Message Clip.

Novelty Message Clips

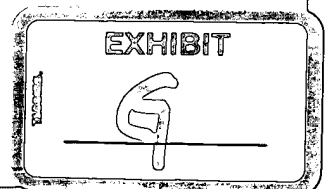
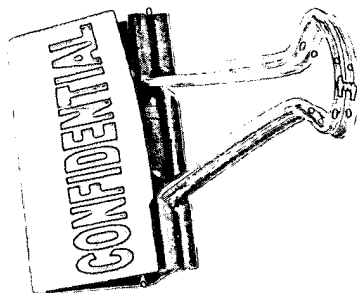
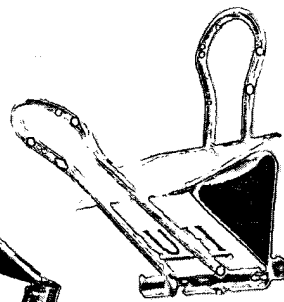
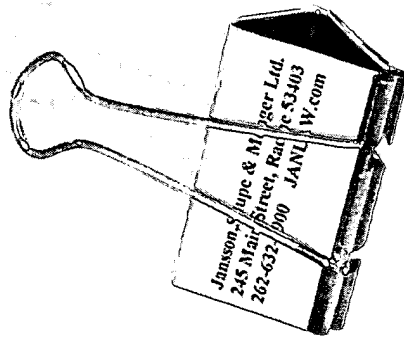
The idea of wrapping a material around binder clips can be expanded to include all types of textures and materials. Examples include the following:

- | | |
|----------------|------------------|
| •Any Color | •Holograph |
| •Cloth | •Leather |
| •Colored Glass | •Marble |
| •Copper | •Photograph |
| •Fur | •Simulated Wood |
| •Granite | •Stainless Steel |

The variety of plastic and other materials that can be wrapped around a standard binder clip to transform it into a Message Clip is only limited by the imagination.

Potential Licensees of the Patent

1. Manufacturers of binder clips
2. Other paper fastener manufacturers
3. Plastic molding manufacturers
4. Promotional product manufacturers
5. Manufacturers of printed plastic clips
6. Office accessory manufacturers
7. Button and pin manufacturers
8. Marketing firms



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